

REMARKS

The Official Action mailed January 27, 2006, has been received and its contents carefully noted. Filed concurrently herewith is a *Request for One Month Extension of Time*, which extends the shortened statutory period for response to May 27, 2006. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the full consideration of the Information Disclosure Statements filed on November 30, 2001; September 20, 2002; May 9, 2003; January 30, 2004; June 16, 2004; March 8, 2005; June 27, 2005; August 11, 2005; and October 12, 2005.

The present *Amendment* constitutes a fourth request for consideration of the IDS filed on November 2, 2001 (received by OIPE on January 16, 2002). In the *Amendment* filed March 8, 2005, the Applicant noted that an Information Disclosure Statement (1 page) and PTO 1449 forms (8 pages) were filed on November 2, 2001, and received by OIPE on January 16, 2002. Also, in a previous response, the Applicant attached a copy of the stamped received post card and a copy of the IDS and 1449 forms as filed. The U.S. references cited in the IDS filed November 2, 2001, are readily available to the Examiner. Foreign and non-patent literature references cited in this IDS are to be found in the copending applications Serial Nos. 08/943,333 (abandoned), 08/372,899 (pending), 07/993,391 (abandoned) and 07/837,394 (issued as U.S. Patent No. 5,200,846). If there are any particular references that cannot be located by the Examiner in Serial Nos. 08/943,333, 08/372,899, 07/993,391 and 07/837,394 applications, the Applicant requests that such references be identified in a subsequent communication. If the Examiner is unable to comply with the rules, it is respectfully requested that the Examiner discuss the matter with the Director of the Technology Center to find out what other remedies may be available.

Under 37 CFR 1.98(d)(1), the Applicant is permitted to rely on an earlier submission of prior art in a parent application if the "earlier application is properly identified in the information disclosure statement and is relied on for an earlier effective

filings date under 35 U.S.C. 120." The Applicant respectfully submits that copies of the references cited in the Information Disclosure Statement are available in the copending parent applications, Serial Nos. 08/943,333, 08/372,899, 07/993,391 and 07/837,394. The above-referenced applications are properly identified in the Information Disclosure Statement, and the application data sheet shows that the present application claims the benefit of priority from the above-referenced applications. As such, the Applicant respectfully submits that the Information Disclosure Statement fully complies with 37 CFR 1.98 and must be considered by the Examiner. As stated in MPEP § 609.III.C(2), "items of information listed that do comply with the requirements of 37 CFR 1.97 and 37 CFR 1.98 will be considered by the examiner and will be appropriately initialed" (emphasis added).

It is noted that it has come to the Applicant's attention that the above-referenced IDS contains minor errors, which have been corrected in the copies of the PTO 1449 forms attached to the *Amendment* filed March 8, 2005. Specifically, on page 1 of 8, "McGrievy" has been changed to "McGreivy"; on page 2 of 8, "Moruzumi" has been changed to "Morozumi"; and on page 5 of 8, JP 02-349415 was cited in error. Also, as noted in the IDS filed June 27, 2005, on page 6 of 8, regarding the form of translation of JP 53-144297, "Full Eng" should have been "Abst." Therefore, the Applicant cited JP 53-144297 in the IDS filed June 27, 2005, which has been considered, and the Applicant requested that the Examiner cross through the erroneous citation of JP '297 on page 6 of 8 of the IDS filed November 2, 2001.

It is noted that the Applicant resubmitted the above documents as a courtesy to the Examiner. It is respectfully submitted that the above-referenced Information Disclosure Statement was properly and filed on November 2, 2001, and should be accorded its filing date for the purposes of consideration and compliance with 37 CFR 1.97 and 1.98.

The present *Amendment* constitutes a fourth request for consideration of the IDS filed April 18, 2002 (received by OIPE April 29, 2002). The Applicant received a

partially considered copy of the PTO 1449 form with the Official Action mailed July 21, 2003 (Paper No. 6), a copy of which was attached to the *Amendment* filed March 8, 2005. Specifically, as previously noted by the Applicant, it appears the Examiner overlooked the citation of U.S. Patent No. 5,340,999 to Takeda. U.S. Patent No. 5,340,999 should be readily accessible to the Examiner. Therefore, all pertinent documents are available to the Examiner and the IDS filed April 18, 2002, should be fully considered in due course. Specifically, the Applicant requests an indication of the consideration of the Takeda '999 reference.

Claims 2, 4, 6-9, 19, 21 and 24-58 were pending in the present application prior to the above amendment. Claims 24-36 and 48-58 have been withdrawn from consideration by the Examiner. Accordingly, claims 2, 4, 6-9, 19, 21, 37-42 and 44-47 are currently elected, of which claims 2, 4, 6-9 and 37-42 are independent. The features of dependent claims 15 and 43 have been incorporated into independent claims 2, 4, 6-9 and 37-42. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 2 of the Official Action rejects claims 2, 4, 6-9, 15, 19, 21 and 37-47 as obvious based on the combination of U.S. Patent No. 5,051,570 to Tsujikawa and U.S. Patent No. 4,007,294 to Woods. The Applicant respectfully submits that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some

teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Tsujikawa and Woods or to combine reference teachings to achieve the claimed invention. MPEP § 2142 states that the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. It is respectfully submitted that the Official Action has failed to carry this burden. While the Official Action relies on various teachings of the cited prior art to disclose aspects of the claimed invention and asserts that these aspects could be used together, it is submitted that the Official Action does not adequately set forth why one of skill in the art would combine the references to achieve the features of the present invention.

The test for obviousness is not whether the references “could have been” combined or modified as asserted in the Official Action, but rather whether the references should have been. As noted in MPEP § 2143.01, “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (emphasis in original). Thus, it is respectfully submitted that the standard set forth in the Official Action is improper to support a finding of *prima facie* obviousness.

The features of dependent claims 15 and 43 have been incorporated into independent claims 2, 4, 6-9 and 37-42. Specifically, claims 2, 4, 6-9 and 37-42 have been amended to recite that the claimed pixel electrode is transparent.

The Official Action concedes that Tsujikawa and Woods do not teach that "the pixel electrode is transparent" (page 4, Paper No. 20060123). The Official Action asserts that "[this] invention is an electro-optical display and using a light-transmission type liquid crystal display (see paragraph 0147 of this application), as a general available knowledge, the light-transmission type liquid crystal display using transparent pixel electrode that is benefit from the light transmission property of the transparent electrode" (pages 4-5, Id.). The Official Action asserts that "it would have been obvious to those skilled in the art at the time the invention was made to modify the electro-optical display device of Tsujikawa with the general available knowledge of the transparent electrode having light transmission property, since the skilled in the art would be motivated for the benefit of the light transmission property" (page 5, Id.). The Applicant respectfully disagrees and traverses the above assertions in the Official Action.

Tsujikawa is directed to a light valve. That is, in Tsujikawa, a light signal enters from a rear side of a panel and is detected by the photodiode 101 while projection light enters from a front side of the panel and is reflected by pixel electrode 124. "The pixel electrode 124 has light reflecting and light blocking properties" (column 11, lines 16-18). The light signal and the projection light are used separately in the panel. If pixel electrode 124 were made transparent, the projection light would enter the photodiode through the transparent pixel electrode and the entire device would be rendered inoperable, because the photodiode should be switched by a light signal. Therefore, the Applicant respectfully submits that it would not have been obvious to one of ordinary skill in the art at the time of the present invention to modify Tsujikawa by changing pixel electrode 124 of Tsujikawa into a transparent electrode.

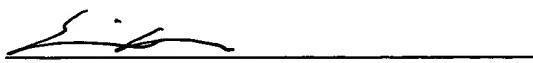
Therefore, the Applicant respectfully submits that the Official Action has not provided a proper or sufficient suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Tsujikawa and Woods or to combine reference teachings to achieve the claimed invention.

In the present application, it is respectfully submitted that the prior art of record, either alone or in combination, does not expressly or impliedly suggest the claimed invention and the Official Action has not presented a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

For the reasons stated above, the Official Action has not formed a proper *prima facie* case of obviousness. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



Eric J. Robinson  
Reg. No. 38,285

Robinson Intellectual Property Law Office, P.C.  
PMB 955  
21010 Southbank Street  
Potomac Falls, Virginia 20165  
(571) 434-6789